
From: Jennifer James <obacanvasco@hotmail.com>
Sent: Monday, March 6, 2017 4:23 PM
To: lynn@cnfei.com
Cc: Ross Dannenberg; info@pcfallon.com
Subject: Re: Trademark Infringement and Copyright Infringement - MERMAID SLEEPS HERE (000679.00024)

Hi,

Your counsel asked for me to direct future correspondence to his attention. He has failed to respond, therefore, I am reaching out to you.

At this time, I also wanted to bring to your attention that your "Mermaid Sleeps Here" pillow is infringing not only on our trademark, but also on our copyright for that design. The only difference is that you omitted the letter "a". Your pillow and one of our pillows in our "A Mermaid Sleeps Here" pillow collection are confusingly similar, right down to the letterstyle and the placement. This is a direct violation of our design copyright.

We have also reached out to several companies that are selling your "Mermaid Sleeps Here" pillow. They seem to believe that it is not illegal for them to sell the pillow since they are simply a vendor and not the retailer. This is incorrect. As the retailer, I would think that you would want to protect your vendors from any legal action they will incur based on your Infringement of our brand, "A Mermaid Sleeps Here".

If you do not cease the current Infringement of our trademark and design copyright, we will be forced to take appropriate legal action against you and your vendors. We will seek all available damages and remedies.

Thank you,
Jennifer

From: Jennifer James <obacanvasco@hotmail.com>
Sent: Wednesday, March 1, 2017 2:57:20 PM
To: Ross Dannenberg
Cc: lynn@cnfei.com
Subject: Re: Trademark Infringement - MERMAID SLEEPS HERE (000679.00024)

Good afternoon,

Your client has their Mermaid Sleeps Here pillow listed as out of stock on their website. Are they planning to restock the pillow or are they in agreement to not sell it anymore?

Thank you,
Jennifer

From: Jennifer James <obacanvasco@hotmail.com>
Sent: Friday, February 17, 2017 5:15:43 PM
To: Ross Dannenberg
Subject: Re: Alleged trademark Infringement - MERMAID SLEEPS HERE (000679.00024)

Mr. Dannenberg,

Thank you, but there is no misunderstanding on my part. Ironically, I believe the misunderstanding is on your part. So, unfortunately, this matter is not closed.

I fully understand the verbiage in your email, but I do not agree with your conclusion. Your client's "decorative use" of our trademark is absolutely a direct violation and dissolution of our mark. Our trademark, "A Mermaid Sleeps Here", is our brand that encompasses over 100 of our own originally designed and fabricated pillows in our Mermaid Pillow Collection. As you clearly stated, our federal trademark registration protects us against anyone using "A Mermaid Sleeps Here" on pillows, embroidered pillows, accent pillows, and throw pillows. As I am sure you know, our registered mark consists of standard characters without claim to any particular font style, size, or color.

To be very clear, our concern is your client's use of our mark, "A Mermaid Sleeps Here", on pillows only. As you noted, that is why we only registered our mark in Class 20. We are not worried with your client or anyone else using "A Mermaid Sleeps Here" on signs, decals, etc. While I appreciate your Apple Computer example, it is not an accurate comparison. Clearly, not apples to apples.

Do know, that after we have reached out to other small and large companies that have used our trademark unknowingly, they have all immediately ceased usage. We currently have several companies that are interested in licensing privileges, but we are not entertaining that idea at this time.

As you stated, your client truly respects the intellectual property rights of others. If this is indeed a fact, then I feel confident that they will stop infringing on our trademark immediately. If not, I will have no other choice, but to advise my attorney to send a Cease and Desist letter to your client.

Thank you,
Jennifer

From: Ross Dannenberg <RDannenberg@bannerwitcoff.com>
Sent: Friday, February 17, 2017 2:13:01 PM
To: obacanvasco@hotmail.com
Cc: Anna King; Maggie Sigur
Subject: Alleged trademark Infringement - MERMAID SLEEPS HERE (000679.00024)

Ms. James,

We represent C&F Enterprises in intellectual property matters, and your below correspondence has been referred to us to address. First let me assure you that C&F Enterprises respects the intellectual property rights of others, and takes their own intellectual property rights very seriously, so receipt of any correspondence of this nature gives us pause and is viewed with appropriate attention. In this instance, however, we believe that you are misunderstanding the scope of your rights in the mark A MERMAID SLEEPS HERE, Reg. No. 5,052,861 in Class 20 for Pillows; Embroidered pillows; Accent pillows; and Throw pillows, dated October 4, 2016. A federal trademark registration only protects against infringing *trademark* use, not against *all* uses whatsoever. For example, imagine the outcome if Apple Computers could prevent all other uses of the word APPLE (they have lots of registrations for the word in isolation). Such a scope of rights would immediately stifle free speech and freedom of expression by others.

In this case, my client's use of the words "Mermaid Sleeps Here" on the face of a pillow is decorative in nature, and is not used as an indicator of the source or origin of a product. Such decorative uses are protected speech, and are not an infringement of your mark. You yourself faced a similar issue when the USPTO rejected your trademark application because the applied-for mark as used on the specimen of record was merely a decorative or ornamental feature of the goods and, thus, did not function as a trademark to indicate the source of your goods and to identify and distinguish

them from others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451, 1454 (TTAB 1987); TMEP §§904.07(b), 1202.03 et seq. Only after you submitted an image of the mark on a tag of a pillow was your application granted. That is the same situation we have here, where my client is using the mark in a decorative manner on the face of a pillow, and not as a trademark. It is well established that if a design is solely or merely ornamental and does not also identify and distinguish source, then its use is not trademark use. (McCarthy, § 7:24). Therefore, my client's decorative use is not an infringement of your trademark rights.

We believe that your below correspondence was sent based on a misunderstanding of your rights in the subject mark, and trust this resolves your concerns. To any extent you disagree, please direct future correspondence to my attention. In the meantime, we consider this matter closed.

Sincerely,
/Ross Dannenberg/

Bcc: client

Ross A. Dannenberg | Attorney
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From: Jennifer James [<mailto:obacanvasco@hotmail.com>]
Sent: Monday, February 13, 2017 6:30 PM
To: Lynn Campbell <lynn@cnfei.com>
Subject: Trademark Infringement

Hi,

I am the registered owner of the trademark "A Mermaid Sleeps Here". The serial number is [#86770744](#). The blue pillow (Mermaid Sleeps Here) that you are currently selling is a direct violation and dissolution of our trademark. I can be contacted at [251-981-2311](tel:251-981-2311). A prompt response would be appreciated.

Thank you,
Jennifer James
OBA Canvas Co